

REMARKS:

Claims 1 and 3 are in the case and presented for consideration.

Claim 1 has been amended.

Claim 2 has been canceled.

Rejections Under 35 U.S.C. § 112:

The Examiner has rejected claims 1-3 under 35 U.S.C. §112, first paragraph, holding that the best mode contemplated by the inventor has not been disclosed. The Examiner points to the following statement in the disclosure as evidence of concealment of the best mode: "it is advantageous if at least one of the additional reducing substances consists in a compound of copper with the character of a reducing substance." Examiner indicates that the disclosure never gives an example of what the copper-containing reducing agent may be. Office Action at p. 2. In order to facilitate prosecution of the application, Applicants have canceled claim 2.

The Examiner has also rejected claims 1-3 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In the Examiner's view, the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Thus, the Examiner holds that, in claim 1, "a highly reactive elemental copper" constitutes new matter. *Id.* at p. 2.

In this vein, Examiner has also rejected claims 1-3 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner holds that, in claim 1, the metes and bounds of the limitation "a highly reactive elemental copper" are indefinite.

Id. at p. 3.

In order to clarify the scope of the present invention, Applicants have amended claim 1 to replace the language "a highly reactive elemental copper" with "elemental copper in nascent form." To be sure, this amendment does not constitute the introduction of new matter. See e.g., paragraph [0016] of the published application, which provides, "...in which the *nascent form of copper* is formed repeatedly and enables the successful course of the dehalogenation process according to the invention." (emphasis added).

Neither does the amendment constitute the introduction of an indefinite term. "Nascent form," the equivalent of the commonly-used Latin term "*in statu nascendi*," is a technical term well-known to persons of skill in the art (see, e.g., the SCOPUS references, submitted herewith) for defining the state in which the electron orbits of a just-released atom of an element are not yet properly arranged and are consequently highly reactive.

Therefore claim 1 as well as claim 3, which depends therefrom, are not indefinite. Claim 2 has been canceled.

Rejections Under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a)

The Examiner has also rejected claims 1-3 as being anticipated under 35 U.S.C. §102(b) or, in the alternative, as obvious under 35 U.S.C. §103(a) over U.S. Patent 5,276,250 to Hagenmaier et al. (hereinafter "Hagenmaier et al."), for the reasons set forth in the previous Office Action. Office action at p. 3.

In response to Applicants' argument that the process of Hagenmaier does not teach the use of carbon and an additional reducing substance ("ARS"), filed in the previous office action, the Examiner responds that the fly ash from coal combustion used in the process of Hagenmaier et al. would contain carbon and an ARS. Office action at p. 4, *citing*

Hagenmaier et al. at col. 6, ll. 35-50.

Applicants submit that the table at col. 6, ll. 35-50 of Hagenmaier et al. provides only general analytical data relating to fly ashes, and from which it is not possible to unambiguously determine whether the ARS of the presently-claimed invention is present in the process according to Hagenmeier et al. The particular components of fly ashes are mentioned there only as elements and there is no teaching regarding both the oxidation state of the given components (which oxidation state is an aspect of the claimed invention, which functions on the ox-redox principle) and the ox-redox potency thereof, which is relevant for evaluation of whether they would be able to perform the ARS's function.

The ARS of the presently-claimed invention is capable of reducing cupric and cuprous ions to elemental copper in nascent form at 250 to 500°C. In this connection, Applicants respectfully note that the Office Action does not indicate which of the components listed in the table is, in fact, the ARS of the presently-claimed invention and show why it is such in the context of ox-redox potentials. Rather, the Office action merely indicates, "fly ash from coal combustion used in the process Hagenmaier would contain carbon and an ARS," without more.

Therefore, in Applicants' view, the process of Hagenmeier et al. does not teach the use of the ARS of the presently-claimed invention and that claims 1 and 3 are patentable over Hagenmeier et al.

Conclusion

Accordingly, the Applicants believe that claims 1 and 3 are now in condition for allowance and favorable action is respectfully requested. No new matter has been added. Should there be any issues that have not been addressed to the Examiner's satisfaction, Applicants invite the Examiner to contact the undersigned attorney.

If any additional fees are due in connection with this response, please charge such fees to Deposit Account No. 14-1431.

Respectfully submitted,

/NADER A. ABADIR/
Nader A. Abadir
Reg. No. 52,537
Attorney for Applicant
Tel. (845) 359-7700

Dated: March 16, 2009

NOTARO & MICHALOS P.C.
100 Dutch Hill Road, Suite 110
Orangeburg, New York 10962-2100
Customer No. 21706

R:\PATAMD\J187-032\Response to 2008 12 23 Office Action\J187-032-AMD2.wpd